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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,672	01/29/2004	B. Raghava Reddy	HES 2001-IP-006029U 1	5419
28857	7590	12/07/2005	EXAMINER	
CRAIG W. RODDY HALLIBURTON ENERGY SERVICES P.O. BOX 1431 DUNCAN, OK 73536-0440			BATES, ZAKIYA W	
			ART UNIT	PAPER NUMBER
			3676	

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/767,672	Applicant(s) REDDY ET AL.	
	Examiner Zakiya W. Bates	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
 4a) Of the above claim(s) 17-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 38-55 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01292004, 10312005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16 and 38-55, drawn to a method of cementing a subterranean zone, classified in class 166, subclass 294.
 - II. Claims 17-37, drawn to a cement composition, classified in class 106, subclass 600+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Craig Roddy on 12/2/05 a provisional election was made without traverse to prosecute the invention of group I, claims 1-16 and 38-55. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

8. The abstract of the disclosure is objected to because the term "is provided" is stated in line 1. Correction is required. See MPEP § 608.01(b).

9. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

10. The abstract of the disclosure is objected to because the last sentence recites purported merits. Correction is required. See MPEP § 608.01(b).

11. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-16 and 38-55 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,767,867.

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

US 6,767,867 discloses a method that includes, with respect to claims 1 and 38, method of sealing a subterranean zone comprising: preparing a cement composition comprising a cementitious material, a dry polymer additive prepared by evaporating water from a polymer emulsion comprising at least one polar monomer (acrylamides) and at least one elasticity enhancing monomer (ethylene), and a mixing fluid; placing the cement composition into the subterranean zone; and allowing the cement composition to set therein. With respect to the depending claims, the reference teaches the limitations as claimed. With respect to claim 43, the reference discloses a method that includes a method for manipulating at least one mechanical property of a set cement composition comprising: selecting an amount of at least one polar monomer

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(acrylamides) and at least one elasticity enhancing monomer (ethylene) suitable to contribute to at least one mechanical property of a set cement composition; preparing a cement composition comprising a cementitious material, a polymer emulsion comprising the at least one polar monomer and the at least one elasticity enhancing monomer, and a mixing fluid; and allowing the cement composition to set. With respect to the depending claims, the reference teaches the limitations as claimed.

14. Claims 1-16 and 38-55 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,184,287, or EP 1024154 (cited by applicant).

US 6,184,287 and EP 1024154 disclose a method that includes, with respect to claims 1 and 38, method of sealing a subterranean zone comprising: preparing a cement composition comprising a cementitious material, a dry polymer additive prepared by evaporating water from a polymer emulsion comprising at least one polar monomer (acrylamides) and at least one elasticity enhancing monomer (butadiene), and a mixing fluid; placing the cement composition into the subterranean zone; and allowing the cement composition to set therein. With respect to the depending claims, the reference teaches the limitations as claimed. With respect to claim 43, the reference discloses a method that includes a method for manipulating at least one mechanical property of a set cement composition comprising: selecting an amount of at least one polar monomer (acrylamides) and at least one elasticity enhancing monomer (butadiene) suitable to contribute to at least one mechanical property of a set cement composition; preparing a cement composition comprising a cementitious material, a polymer emulsion comprising the at least one polar monomer and the at least one

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elasticity enhancing monomer, and a mixing fluid; and allowing the cement composition to set. With respect to the depending claims, the reference teaches the limitations as claimed.

15. Claims 1-14 and 43-55 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,171,386, US 5,688,844, US 5,795,924, or US 5,588,488.

US 6,171,386 (cited by applicant) discloses, with respect to claim 1, a method that includes a method of sealing a subterranean zone comprising: preparing a cement composition comprising a cementitious material, a polymer emulsion comprising at least one polar monomer (vinyl acetate) and at least one elasticity enhancing monomer (ethylene, butadiene), and a mixing fluid; placing the cement composition into the subterranean zone; and allowing the cement composition to set therein. With respect to the depending claims, the reference teaches the limitations as claimed. With respect to claim 43, the reference discloses a method that includes a method for manipulating at least one mechanical property of a set cement composition comprising: selecting an amount of at least one polar monomer and at least one elasticity enhancing monomer suitable to contribute to at least one mechanical property of a set cement composition; preparing a cement composition comprising a cementitious material, a polymer emulsion comprising the at least one polar monomer (vinyl acetate) and at least one elasticity enhancing monomer (ethylene, butadiene), and a mixing fluid; and allowing the cement composition to set. With respect to the depending claims, the reference teaches the limitations as claimed.

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US 5,795,924, US 5,688,844, and US 5,588,488 (all 3 cited by applicant) disclose, with respect to claim 1, a method that includes a method of sealing a subterranean zone comprising: preparing a cement composition comprising a cementitious material, a polymer emulsion comprising at least one polar monomer (acrylamide, acrylic acid) and at least one elasticity enhancing monomer (butadiene), and a mixing fluid; placing the cement composition into the subterranean zone; and allowing the cement composition to set therein. With respect to the depending claims, the references teach the limitations as claimed. With respect to claim 43, the references disclose a method that includes a method for manipulating at least one mechanical property of a set cement composition comprising: selecting an amount of at least one polar monomer and at least one elasticity enhancing monomer suitable to contribute to at least one mechanical property of a set cement composition; preparing a cement composition comprising a cementitious material, a polymer emulsion comprising the at least one polar monomer (acrylamide, acrylic acid) and at least one elasticity enhancing monomer (butadiene), and a mixing fluid; and allowing the cement composition to set. With respect to the depending claims, the references teach the limitations as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya W. Bates whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Zakiya W. Bates
Primary Examiner
Art Unit 3676

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December 4, 2005